

REMARKS

Status of the Application

Claims 1-30 are all the claims pending in the application. Claims 1-6, 10-17, 20, 22, 23, 24, 26, 27 and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson, US Patent 6,538,698. Claims 7, 8, 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson, USP 6,538,698, in view of Nagasaka et al., US Patent 6,341,168. Claims 9 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson, US Patent 6,538,698, in view of Misawa, US Publication 2003/0154190. Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson, US Patent 6,538,698, in view of Endo, US Patent 6,965,403.

By this Amendment, Applicants are amending claims 1, 20 and 24, and are canceling claim 30. Applicants respectfully submit that this amendment be entered and considered, as the subject matter and combination have been previously presented to the Examiner in prior pending claim 30, and no new search or consideration are necessary.

Claim Rejections - 35 U.S.C. § 102

Claims 1-6, 10-17, 20, 22, 23, 24, 26, 27 and 29 are rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson, US Patent 6,538,698.

Claim 1 recites, in part, “displaying at least two intra-group image frames on said display panel in a state arranged along a second line different from said first line, said at least two intra-group image frames being included in an image group of said specified principal image frame”

The Examiner continues to allege that Anderson discloses all of the elements of claim 1.

Applicant respectfully disagrees.

Per an Examiner Interview conducted February 6, 2008, the Examiner continues to assert that element 704 of Anderson corresponds to the second line recited in claim 1. Further, the Examiner argues that because the claim language says “at least one”, then a single image (i.e., one point) is enough to establish a second line. Therefore, in FIGS. 11A and 11B, the line represented by thumbnail images 700 would correspond to the recited first line. The Examiner asserts that if cursor 702 highlights thumbnail 5 (see FIG. 11B), then large thumbnail 5 will be displayed at location 704, thereby establishing the second line recited in claim 1. The Examiner cited to col. 5, lines 6-10 of Anderson to support the Examiner’s assertion that a large thumbnail would be displayed at location 704.

The Examiner conceded during the interview that if claim 1 were amended to recite “at least two image frames ... arranged along a second line,”, then claim 1 would no longer be anticipated by Anderson, as Anderson only shows a single image being disposed in the second line. Therefore, Applicants respectfully submit that claim 1 is hereby patentable over the applied art.

Claims 20 and 24 recite similar features to claim 1, and accordingly are patentable over Anderson for the same reasons.

The remaining claims are patentable based on their respective dependencies.

With further regard to claim 2, we would submit that the claim describes an intersection of the first and second lines at the specified principle image frame. To the extent that FIG. 11B

can be construed to show two lines, there will not necessarily be an intersection at the specified frame. For example, if frame 5 is specified, the expanded image will still display at position 704, which does not correspond to intersection at frame 5. See also claim 27. Therefore, at a minimum, claims 2 and 29 are patentable **regardless of the entry of the amendment**.

Additionally, Applicants respectfully submit that claim 29 is patentable for reasons independent of its dependency. Claim 29 recites, “wherein the second line is perpendicular to the first line. The Examiner fails to reject claim 29 with specificity. However, assuming, *arguendo*, that images 5 and 6 are displayed on a second line as recited in claim 1, as seen in FIG. 11B, images 5 and 6 are shown in parallel to a first line including composite images 1 and 4. Therefore, Anderson cannot disclose that the second line is perpendicular to the first line, as recited in claim 29. Claim 29 is patentable over the applied art.

Claim Rejections - 35 U.S.C. § 103

Claims 7, 8, 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson, US Patent 6,538,698, in view of Nagasaka et al., US Patent 6,341,168.

Claims 7, 8, and 19 depend from claim 1, which has been shown above to be patentable over Anderson. Nagasaka does not cure the deficiencies of Anderson. Thus, Applicant respectfully submits that claims 7, 8, and 19 are patentable over the Nagasaka and Anderson combination.

Claims 9 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson, US Patent 6,538,698, in view of Misawa, US Publication 2003/0154190.

Under 35 U.S.C. § 103(c), subject matter developed by another person, which qualifies as prior art only under one of § 102(e), (f), and (g), shall not preclude patentability under § 103 where the subject matter and the claimed invention were, at the time the claimed invention was made, subject to an obligation of assignment to the same person.

Applicant respectfully notes that Misawa qualifies as prior art under § 102(e) and 102(a). Applicant hereby submits a certified English language translation of the priority document for the instant application (JP2003-083450) in order to perfect priority. Thus the effective priority date of the instant application is March 25, 2003, which falls prior to the August 14, 2003 publication date of Misawa, meaning that Misawa is only available as prior art under 35 U.S.C. § 102(e).

Moreover, both Misawa and the instant application are assigned to FujiFilm Corporation. U.S. Patent and Trademark Office assignment records show that the assignment in Misawa was recorded on February 14, 2003 at Reel/Frame 013777/0148. Therefore, Applicant respectfully submits that at the time the claimed invention was made, the subject matter of Misawa and the claimed invention were subject to an assignment to the same person. As such, pursuant to 35 U.S.C. § 103(c), the subject matter of Misawa shall not preclude the patentability of the claimed invention.

Since none of the remaining references of record, alone or in combination, teach all the features of claim 9, as acknowledged by the Examiner, Applicant respectfully submits that the claim 9 is patentable, and thus Applicant respectfully requests the Examiner to withdraw the rejection.

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson, US Patent 6,538,698, in view of Endo, US Patent 6,965,403.

Claim 18 depends from claim 1, which has been shown above to be patentable over Anderson. Endo does not cure the deficiencies of Anderson. Thus, Applicant respectfully submits that claim 18 is patentable over the Endo and Anderson combination.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Dion R. Ferguson/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Dion R. Ferguson
Registration No. 59,561

Date: February 26, 2008